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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/314,172	05/19/1999	HIROKI KANNO	016907/0967	4798

7590 03/13/2002  
FOLEY & LARDNER  
SUITE 500  
3000 K STREET N W  
WASHINGTON, DC 200075109

EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 03/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/314,172

Applicant(s)  
Hiroki Kanno

Examiner  
Madeleine AV Nguyen

Art Unit  
2622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Feb 25, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above, claim(s) 10-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 20) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uda (US Patent No. 5,822,507).

Concerning claim 1, Uda discloses an image forming apparatus (Fig.1) comprising reading means (103a-b) for reading a document; image processing means (102); image forming means (104a-d) for forming an image on an image formation medium; image formation condition-producing means (107) for producing an image indicative of status information; means for controlling the image forming means (101) to form the image from the image formation condition-producing means on the image formation medium (Figs.1-6, 14-20; Abstract; col. 2, lines 35-49; col. 3, line 35 - col. 5, line 17).

Uda does not specifically teaches that the status information are the operating conditions of the devices. However, it was commonly known in the art that the status information of a machine is equivalent to the operating conditions since both of them represent the state or the condition of the machine. It would have been obvious at the time the invention was made to a

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person having ordinary skill in the art to consider the status information in Uda equivalent to the operating conditions as claimed since Uda also teaches that the image formation condition-producing means 107 produces the status information of at least one of the reading means, the processing means and the image formation means to the controlling means 101.

Concerning claims 2-9, Uda further teaches that the image formation condition-producing means includes means for producing a character image, a pattern code (Fig.20); means for producing an image indicative conditions of the reading means or image forming means or of the image processing means; means for forming an image indicative of a resolution, a sampling rate of the reading means (Figs.3-6, 14-20; col. 1, lines 58 - col. 2, line 22; col. 6, line 41 - col. 7, line 28; col. 10, line 32 - col. 11, line 21; col. 12, lines 31 - col. 15, line 21; col. 18, lines 25-63; col. 20, lines 8-25; col. 20, lines 8-54).

Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uda as applied to claim 1 above, and further in view of Kohtani et al (US Patent No. 5,475,475).

Concerning claims 8-9, Uda fails to teach the synthesizing means for synthesizing a plurality of images into one. However, it was commonly known the art to synthesize different images from different sources to a single image. Kohtani et al support that well known in the prior art by disclosing an image forming apparatus and method in which image of a plurality of originals are formed at different positions of one recording sheet (Fig.6; Abstract). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the teaching of Kohtani et al to the system in Uda since system in Uda is connected to a

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plurality of scanner and printer which can receive or transmit different scanned images for printing.

***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Yamada (US Patent No. 5,659,770) teaches a text/image processing apparatus determining synthesis format.

b. Shigeeda et al (US Patent No. 5,694,486) discloses an image processing apparatus and method for designating one of a plurality of operating modes.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine Anh-Vinh Nguyen whose telephone number is (703) 305-4860.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, DC 20231

or faxed to:

(703) 308-9051 (for formal communication as intended for entry)

(703) 308-9051 (for informal or draft communications, such as proposed amendments to be discussed an interview; please label such communications "PROPOSED" or "DRAFT")

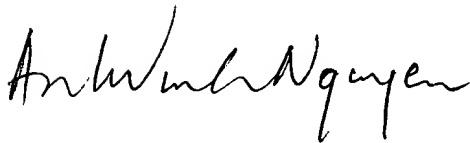
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or hand-carried to:

Crystal Park Two  
2121 Crystal Drive  
Arlington, VA.  
Sixth Floor (Receptionist)

A handwritten signature in cursive script, reading "Anh Vinh Nguyen". The signature is written in black ink and is positioned above the printed name.

Madeleine Anh-Vinh Nguyen  
Primary Examiner  
Art Unit 2722  
March 11, 2002